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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,186	09/29/2000	Johan Kiessling	026125-069	9330

7590 07/16/2003

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EXAMINER

SHARMA, SUJATHA R

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 07/16/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,186

Applicant(s)

KIESSLING ET AL.

Examiner

Sujatha Sharma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Arguments

The applicant argues that the reference Vatanen [WO 99/01848] was filed on February 9, 2000 and published on August 17, 2000. However the reference Vatanen [WO 99/01848] was filed on 16 June 1998 and published on 14 January 1999 and hence qualifies as prior art. Therefore the rejections discussed in the previous office action (paper no.9) are considered proper.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6,9,10,15,17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Vatanen [WO 99/01848].

Regarding claims 1,9 and 17-20, Vatanen discloses a method of secure session set up between the application control server and the SIM card connected to the terminal device. Vatanen further discloses a method of establishing an agreement proposal for a secure transaction from the server to a security adapter connected to the network (see page 6, lines 3-37, Fig.2). Vatanen further discloses a method of activating a signing application, sending the signed data from the

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communication device to the security adapter, verifying the signature for the data and sending the verified signed data to the server for execution of the transaction (see page 3, lines 10-25, page 4, lines 21-34 and Fig.2).

Regarding claim 2, Vatanen further discloses a method where the information browsing (see page 1, lines 8-18) is further initiated by the communication device where the information is transferred over the network between the communication device and the application server (see page 6, lines 3-10).

Regarding claims 3 and 6, Vatanen further discloses a method of sending a request requiring secure transaction of data from the communication device (see page 6, lines 11-20).

Regarding claim 4, Vatanen further discloses a method of sending sign request into atleast one message and sending the said message from the security adapter to the smart card in the communication device to initiate the signing application and displaying the details of the transaction and a prompt for an accept on the communication device (see page 6, line 3 – page 7, line 3 and page 7, lines 22-36 and Fig.2).

Regarding claims 5,10, Vatanen further discloses the use of a program/algorithm with a secret/private key for activating and closing of the signing application (see page 3, lines 1-25 and page 4, lines 21-34),

Regarding claim 15, Vatanen further discloses the communication device to be a mobile phone with transmitting and receiving capability (see Figs.1, summary of invention).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7,8,11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vatanen [WO 99/01848] in view of Geiger [US 6,463,534] and further in view of Sandgren [WO 98/57511].

Regarding claims 7 and 11, Vatanen as treated in claims 1 and 9 does not disclose the use of a WAP protocol for data transfer and the use of SMS messaging and the signing application a SIM application toolkit application.

Geiger in the same field of endeavor teaches the use of WAP protocol for data transfers. See col. 2, lines 49-55. Geiger also teaches the use of SMS messaging for transfer of messages. See col.10, lines 1-29.

Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to provide the teachings of Geiger to Vatanen to use the WAP protocol in order to use the mobile device for a world wide communication network such as the internet.

Vatanen modified with Geiger's teaching does not disclose the use of SIM application toolkit.

Sandgren in the same filed of endeavor teaches the use of SIM application toolkit to lock or unlock the signing application on the SIM card. See summary of invention and page 3, lines 10-28.

Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to provide the teachings of Sandgren to the modified Vatanen's invention in order to enhance the security of the usage of the SIM card especially in using the SIM cards for secure transmissions such as banking.

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Sandgren further teaches the use of SMS/USSD messaging between the terminal device and the operator for locking/unlocking of the SIM card. See summary of invention and page 4, lines 3-30.

Regarding claim 8, Vatanen as treated in claim 7, discloses all the limitations as claimed.

However Vatanen does not explicitly disclose the method of suspending/terminating the WAP/browser application while the SIM application toolkit application for the signing application is activated. However, it is obvious to one with ordinary skill in the art at the time the invention was made, that the browser application is suspended while the authentication/signing application is initiated in order to ensure a secure transaction between the terminal device and the application server especially in applications such as banking.

Regarding claims 12-14, Geiger further teaches a mobile telephone network, Internet for connecting to the application server and a WAP/wireless gateway connecting the mobile network to the Internet (see Fig.4 and col.11, lines 29-63).

Regarding claims 13 and 14, Geiger further discloses the security adapter connected to the WAP gateway and the application server (see Fig.4).

3. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vatanen [WO 99/01848] in view of Tsoi [US 5,425,077].

Vatanen as treated in claims 9 and 15 does not disclose a method of displaying a particular icon, font or color to indicate the status of the mobile phone.

Tsoi teaches a method of displaying a visual display of the status of the mobile telephone (See col. 6, lines 1-17).

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Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to provide the teachings of Tsoi to Vatanen in order to indicate to the user the status of the communication mode especially during a secure transaction.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sujatha Sharma whose telephone number is 703-305-5298. The examiner can normally be reached on Mon-Fri 7.30am - 4.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 703-305-4778. The fax phone numbers for the organization where this application or proceeding is assigned and for all official communications is 703-872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.


Sujatha Sharma
July 14, 2003


DWAYNE BOST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600